

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN M. SIEGEL and GREG GUDORF

Appeal 2007-1517
Application 09/726,973
Technology Center 2100

Decided: July 31, 2007

Before JOHN C. MARTIN, LEE E. BARRETT, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the
Examiner's rejection of claims 1-18.

We AFFIRM.

THE INVENTION

The disclosed invention relates generally to methods of providing information over the Internet and more particularly to providing a user with a personalized Internet experience responsive to the user's interests and background (Specification 1).

Independent claim 1 is illustrative:

1. A method of personalizing information presented at a host web site comprising:
 - assigning a unique ID to each device among a plurality of devices used for presenting the personalized information;
 - using the host web site for obtaining personal data about a user during a visit to the host web site;
 - after the host web site obtains the personal data about the user, using the host web site for monitoring the content of information viewed by the user while the user visits other web sites; and
 - during a subsequent visit by the user to the host web site, personalizing the information presented to the user, wherein the host web site modifies the content of the information presented to the user based upon the unique ID of the device used to access the host web site, the personal data obtained about the user and the content of the other web sites visited by the user, wherein the content of the information presented to the user is different for each unique ID assigned to each device among the plurality of devices.

THE REFERENCES

Mitchell	US 2002/0013850 A1	Jan. 31, 2002 (filed Jun. 28, 2000)
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Nickerson	US 6,606,581 B1	Aug. 12, 2003 (filed Jun. 14, 2000)
Subramonian	US 6,701,362 B1	Mar. 2, 2004 (filed Feb. 23, 2000)
Philyaw	US 6,836,799 B1	Dec. 28, 2004 (filed Aug. 24, 1999)
Haitsuka	US 6,847,992 B1	Jan. 25, 2005 (filed Jul. 31, 2000)

THE REJECTIONS

Claims 1-18 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 2, 4-7, 13, and 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Mitchell in view of Haitsuka.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Mitchell in view of Haitsuka, and further in view of Subramonian.

Claims 8-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Mitchell in view of Haitsuka, and further in view of Official Notice.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Mitchell in view of Haitsuka, and further in view of Nickerson.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Mitchell in view of Haitsuka, and further in view of Philyaw.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs, the Final Action, and the Answer for the respective details thereof.

Written Description Requirement

The Examiner has raised a new ground of rejection for claims 1-18 under 35 U.S.C. § 112, first paragraph (Answer 4). The Examiner contends the Specification fails to disclose assigning a unique ID to each device among a plurality of devices used for presenting the personalized information, in addition to using the assigned unique ID in the manner claimed (*id.*). In particular, the Examiner finds the disclosure of paragraphs [0006], [0009], and [0012] inadequate to support the instant claims (*id.*).

In response, Appellants contend support can be found in the Specification at pages 2-4, paragraphs [0007]-[0011] (Reply Br. 4-5).

We note that the Court of Appeals for the Federal Circuit has held that “[t]o fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed.” *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003) (citations omitted). Our reviewing court has cautioned, however, that “[t]he disclosure as originally filed does not . . . have to provide *in haec verba* support for the claimed subject matter at issue.” *id.* at 1364, 67 USPQ2d at 1885. “Although [the applicant] does not have to describe exactly the subject matter claimed, . . . the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614,

1618 (Fed. Cir. 1989) (citations omitted). Put another way, “the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*.” *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, “[p]recisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis.” *Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (citation omitted).

Here, we find paragraph [0009] of the Specification conveys with reasonable clarity to those skilled in the art that Appellants were in possession of the invention as of the instant filing date:

[0009] In certain preferred embodiments, a user may be assigned a unique identity that is linked to the personal computer (PC) used to access the host web site. For example, a user may visit business related web sites from a first PC at work and entertainment related sites from a second PC at home. The host web site of the present invention desirably assigns a first cookie to the user's work PC and a second cookie to the user's home PC. The cookie assigned to the work PC will track and monitor the web sites that the user visits at work. This information will be stored in a database maintained by the server of the host web site. The cookie assigned to the home PC will track and monitor the web sites that the user visits at home. This information will also be stored by the server of the host web site. The information stored about usage of the work PC will have a different content than the information stored on usage of the home PC. As a result, the user's experience when visiting the host web site may be very different depending upon which PC is utilized to visit the host web site.

(Specification 3-4, ¶ [0009]).

While not providing literal support, we nevertheless find the recited language “assigning a unique ID to each device” is adequately supported by the disclosed unique user identity that is *linked to the personal computer (PC) used to access the host web site (id.)*. For example, if two individuals use different computers to access a web site, and each user has a unique user ID that is *linked* to their own computer, then a unique ID has effectively been assigned (i.e., linked) to each computer (i.e., device). For at least the aforementioned reasons, we find sufficient detail has been disclosed in the Specification to satisfy the written description requirements of 35 U.S.C. § 112, first paragraph.

Obviousness

We consider next the Examiner’s rejection of claims 1, 2, 4-7, 13, and 15-17 as being unpatentable over the teachings of Mitchell in view of Haitsuka. Since Appellants’ arguments with respect to this rejection have treated these claims as a single group which stand or fall together, we will select independent claim 1 as the representative claim. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

Mitchell discloses using cookies to store identification codes representing user IDs (Mitchell 6, para. [0049]). The Examiner contends that Haitsuka teaches “assign[ing] a unique ID (e.g. cookie) to each device among a plurality of device used for presenting the personalized information (col. 2, lines 64-67, col. 3, lines 1-3, 11-20)” (Answer 6) and that a “cookie is inherently known to contain user or device information.” (*Id.*)

Appellants argue Haitsuka does not inherently disclose that a cookie contains device information (Br. 8).

The Examiner disagrees. The Examiner contends that the rejection is based on the interpretation that Haitsuka's "cookie" *is* the unique ID in the same manner that Appellants' "cookie" provides the unique ID assigned to each device, as the Examiner contends Appellants have argued (Answer 12-13).

After carefully considering all of the evidence before us, we find that we need not reach the issue of inherency to decide this appeal. The Supreme Court has recently reaffirmed that "[s]ection 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

Here, Haitsuka explicitly discloses that "Cookies are computer-specific, not user-specific." (Haitsuka, col. 3, ll. 14-15). Also, as noted by Appellants (Reply Br. 7), Haitsuka explains that "[c]ookies can be used by a web server to customize pages for a user's browser type" (col. 3, ll. 11-13). We understand this to mean that a single user who uses two computers having different types of browsers will have different cookies stored on each computer. Thus, we find that Haitsuka would have *suggested* to a person having ordinary skill in the art that a cookie could have been made "computer-specific" by including within the cookie's data a unique ID assigned to a device (i.e., computer). We note the primary Mitchell

reference teaches the use of cookies to store a user ID such that user systems are automatically recognized, even when the user does not log in (Mitchell 6, ¶ [0049], ll. 1-8). Thus, we find that Haitsuka's teaching of computer-specific cookies would have further improved Mitchell's system by providing the enhanced capability of uniquely distinguishing computers (in a manner either independent of or in association with a user ID). Accordingly, we sustain the Examiner's rejection of independent claim 1 as being unpatentable over Mitchell in view of Haitsuka.

Pursuant to 37 C.F.R. § 41.37(c)(1)(vii), we have decided the appeal with respect to the remaining claims in this group on the basis of the selected claim alone. Therefore, we will sustain the Examiner's rejection of claims 2, 4-7, 13, and 15-17 as being unpatentable over Mitchell in view of Haitsuka for the same reasons discussed *supra* with respect to representative claim 1.

Dependent claims 3, 8-12, 14, and 18

We further note that Appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 3, 8-12, 14, and 18. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004). Therefore, we will sustain the Examiner's rejection of claim 3 as being unpatentable over Mitchell in view of Haitsuka and Subramonian. We will also sustain the Examiner's rejection of claims 8-12 as being unpatentable over Mitchell in view of Haitsuka and Official Notice. Likewise, we will

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sustain the Examiner's rejection of claim 14 as being unpatentable over Mitchell in view of Haitsuka and Nickerson. Lastly, we will sustain the Examiner's rejection of claim 18 as being unpatentable over Mitchell in view of Haitsuka and Philyaw.

CONCLUSION

We have sustained at least one rejection for each claim on appeal. Therefore, the decision of the Examiner rejecting claims 1-18 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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